

REMARKS

In response to the Office Action dated April 21, 2004, Applicants respectfully request reconsideration based on the above claim amendments and the following remarks. Applicants respectfully submit that the claims as presented are in condition for allowance.

Claims 1-35 are pending in the application. Claims 15-18 and 27-35 are withdrawn and Applicants reserve the right to resubmit them in a subsequent divisional application. Claims 1, 5, 9, 19, and 26 are amended. Claims 1, 9, 19, and 26 are amended to include a portion of the subject matter of original claim 5, that portion being removed from claim 5.

The Examiner imposed a restriction requirement under 35 U.S.C. 121, stating that there are five different groups of invention which are unrelated based on MPEP § 806.04 and MPEP § 808.01.

In a telephone conversation with Michael Oblon on April 15, 2004, a provisional election was made without traverse of Group I, claims 1-14 and 19-26. Applicants now elect Group I, claims 1-14 and 19-26 without traverse.

The Office Action rejected claims 1-3, 6-9, 11-13, 19-21 and 25 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication No. 2002/0107027 to O'Neil ("O'Neil").

Anticipation of a claim under 35 U.S.C. 102(e) requires the reference to teach every element of the claim, as arranged in the claim. Applicants traverse the rejection of claims 1-3, 6-9, 11-13, 19-21 and 25, because O'Neil fails to teach every element of these claims as arranged in the claims.

Claim 1 recites, *inter alia*, “(e) storing messages to be transmitted to wireless communications devices in a pending database; (f) transmitting a message stored in the pending database over a forward control channel to a wireless communications device; (g) receiving an acknowledgement from the wireless communications device of receipt of the transmitted message over a reverse control channel.” As stated in the Office Action, the prior art of record fails to teach or suggest these elements, which were included in claim 5 prior to the amendment of claim 1 to include them. (Office Action, page 12, paragraph 12). O’Neil fails to disclose any such pending database or acknowledgment from the wireless communications device.

Similarly, claim 9 recites, *inter alia*, “(g) transmitting the selected advertisement to the wireless communications device over a forward control channel; and (h) receiving an acknowledgement from the wireless communications device of receipt of the selected advertisement over a reverse control channel.” As stated in the Office Action, the prior art of record fails to teach or suggest these elements, which were included in claim 5 prior to the amendment of claim 9 to include them. (Office Action, page 12, paragraph 12). O’Neil fails to disclose any such forward control channel or acknowledgment from the wireless communications device.

Likewise, claim 19 recites, *inter alia*, “(c) storing the advertisement to be transmitted to the wireless communications device in a pending database; (d) transmitting the advertisement stored in the pending database over a forward control channel to the wireless communications device; and (e) receiving an acknowledgement from the wireless communications device of receipt of the transmitted advertisement over a reverse control channel.” As stated in the Office Action, the prior art of record fails to teach or suggest these elements, which were included in claim 5 prior to the amendment of claim 19 to include them. (Office Action, page 12, paragraph 12). O’Neil fails to disclose any such pending database, forward control channel, or acknowledgment from the wireless communications device.

Claims 2-3 and 6-8 depend, directly or indirectly, from claim 1 and, thus, inherit the patentable subject matter of claim 1 in addition to having additional subject matter. Therefore, claims 2-3 and 6-8 are also patentable over O'Neil. Claims 11-13 depend, directly or indirectly, from claim 9 and, thus, inherit the patentable subject matter of claim 9 in addition to having additional subject matter. Therefore, claims 11-13 are also patentable over O'Neil. Claims 20-21 and 25 depend, directly or indirectly, from claim 19 and, thus, inherit the patentable subject matter of claim 19 in addition to having additional subject matter. Therefore, claims 20-21 and 25 are also patentable over O'Neil.

The Office Action rejected claims 14, 23, 24 and 26 under 35 U.S.C. 103(a) as being unpatentable over O'Neil in view of U.S. Patent Application Publication No. 2002/0116271 to Mankoff ("Mankoff").

Obviousness of a claim under 35 U.S.C. 103(a) requires the references to teach or suggest all the elements of the claims. Applicants traverse the rejection of claims 14, 23, 24 and 26, because the combination of O'Neil and Mankoff fails to teach or suggest all the element of these claims.

Claims 14, 23, and 24 depend, directly or indirectly, from claim 1 and, thus, inherit the patentable subject matter of claim 1 in addition to having additional subject matter. As stated in the Office Action, the prior art of record fails to teach or suggest elements, which were included in claim 5 prior to the amendment of claim 1 to include them. (Office Action, page 12, paragraph 12). O'Neil and Mankoff fail to disclose any pending database or acknowledgment from the wireless communications device.

Claim 26 recites, *inter alia*, "(b) storing advertisement coupons to be transmitted to the wireless communications device in a pending database; (c) transmitting an advertisement coupon stored in the pending database over a forward control channel to the wireless communications device; and (d) receiving an

acknowledgement from the wireless communications device of receipt of the transmitted advertisement coupon over a reverse control channel.” As stated in the Office Action, the prior art of record fails to teach or suggest elements, which were included in claim 5 prior to the amendment of claim 26 to include them. (Office Action, page 12, paragraph 12). O’Neil and Mankoff fail to disclose any pending database, forward control channel, or acknowledgment from the wireless communications device.

The Office Action rejected claims 4 and 22 under 35 U.S.C. 103(a) as being unpatentable over O’Neil in view of U.S. Patent Application Publication No. 2002/0102993 to Hendrey et al. (“Hendrey”).

Obviousness of a claim under 35 U.S.C. 103(a) requires the references to teach or suggest all the elements of the claims. Applicants traverse the rejection of claims 4 and 22, because the combination of O’Neil and Hendrey fails to teach or suggest all the element of these claims.

Claims 4 and 22 depend, directly or indirectly, from claims 1 and 19, respectively, and, thus, inherit the patentable subject matter of claims 1 and 19 in addition to having additional subject matter. As stated in the Office Action, the prior art of record fails to teach or suggest elements, which were included in claim 5 prior to the amendment of claims 1 and 19 to include them. (Office Action, page 12, paragraph 12). O’Neil and Hendrey fail to disclose any pending database or acknowledgment from the wireless communications device.

The Office Action rejected claim 10 under 35 U.S.C. 103(a) as being unpatentable over O’Neil in view of U.S. Patent No. 6,161,142 to Wolfe et al. (“Wolfe”).

Obviousness of a claim under 35 U.S.C. 103(a) requires the references to teach or suggest all the elements of the claims. Applicants traverse the rejection of

claim 10, because the combination of O'Neil and Wolfe fails to teach or suggest all the element of this claim.

Claim 10 depends from claim 9 and, thus, inherits the patentable subject matter of claim 9 in addition to having additional subject matter. As stated in the Office Action, the prior art of record fails to teach or suggest these elements, which were included in claim 5 prior to the amendment of claim 9 to include them. (Office Action, page 12, paragraph 12). O'Neil and Wolfe fail to disclose any such forward control channel or acknowledgment from the wireless communications device.

The Office Action objected to claim 5 as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicants amended the independent claims, 1, 5, 9, 19, and 26, to include patentable subject matter from claim 5 and, therefore, respectfully submit that all of the claims are allowable.

For all the reasons advanced above, it is respectfully submitted that the application is in condition for allowance. Accordingly, reconsideration and allowance of the claims are respectfully requested. The Examiner is cordially requested to telephone, if the Examiner believes that it would be advantageous to the disposition of this case.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment, which may be required for this amendment, to Deposit Account No. 06-1130. In the event that an extension of time is required, or may be required in addition to that requested in any petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 06-1130.

Respectfully submitted,

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